

**PATENTABILITY ARGUMENTS****A. Claim Objections**

In item 5, the Examiner has objected to claims 7 through 9 for containing the language "said means for affixing" that following the previous amendment lacks antecedent basis. Applicant has amended claim 7 to replace this phrase with "cavity to receive" and replaced the word "is" with the phrase "further comprises" to overcome this objection. In addition claims 8 and 9 have been separately incorporated into claim 1 and have thus been cancelled without prejudice.

**B. Response to 35 U.S.C. §102 (b) Rejections**

In item 7, the Examiner rejects claims 1-2, 7 and 10 as being anticipated by U.S. patent 5,154,068 issued to DiDomenico under 35 USC §102 (b). For the Examiner to maintain a rejection under 35 U.S.C. §102(b) every element of Applicant's invention must be taught by the cited reference.

Regarding claim 1 the Examiner states that DiDomenico teaches an ear lobe protector comprising a shaft 20 being mounted on a base 18, a connector 12 having a top surface 24 and a bottom surface 26, a cavity 24 with means for engaging the shaft that fits flush against said pierced ear 50 on said bottom surface and an adapter 28 projecting from said top surface of the connector on the obverse and a cap 14 having a cavity 36 to receive said adapter on one side and a decorative aspect of the earring attached on the obverse 30. Applicant respectfully disagrees.

Applicant has amended claim 1 to include the limitations of claim 8 that more clearly defines the adapter as being a nipple. In addition, the amendments more clearly define the cap now comprising a flexible component capable of expanding to receive the nipple and retracting to grasp the nipple when the nipple and the cavity are pressed together.

The DiDomenico patent cited by the Examiner does not claim, teach, disclose, show or discuss a nipple adapter on a connector that interfaces with a cavity of a cap. Nor does DiDomenico claim, teach, disclose, show or discuss that the cap comprises a flexible component that expands to receive the nipple and retracting to grasp the nipple when the nipple and the cavity are pressed together. Consequently, the Examiner's argument can no longer support a rejection of claim 1 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

The Examiner further rejects dependent claims 2, 7 and 10 for the same reasons stated above in claim 1. Based on Applicant's arguments presented above the Examiner cannot support a rejection of these claims based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

In item 8, the Examiner rejects claims 1 and 9 under 35 USC 102(b) as being anticipated by patent 5,743,113 issued to Kogen. In regards to claim 1, the Examiner states that Kogen teaches an earlobe piercing protector comprising a shaft 22 mounted on a base 26, a connector 30 having a top surface 36 and a bottom surface 34, a cavity 38 with a means for engaging the shaft 22 that fits flush against pierced ear 24 on the bottom surface and an adapter 42 projecting from the top surface of the connector on the obverse and a cap 32 having cavity 54 to receive the adapter on one side and a decorative aspect of the earring on the obverse 62. Applicant respectfully disagrees.

Applicant has amended claim 1 to include the limitations of claim 8 that more clearly defines the adapter as being a nipple. In addition, the amendments more clearly define the cap now comprising a flexible component capable of expanding to receive the nipple and retracting to grasp the nipple when the nipple and the cavity are pressed together.

The Kogen patent cited by the Examiner does not claim, teach, disclose, show or discuss a nipple adapter on a connector that interfaces with a cavity of a cap. Nor does Kogen claim, teach, disclose, show or discuss that the cap comprises a flexible component that expands to receive the nipple and retracting to grasp the nipple when the nipple and the cavity are pressed together. Consequently, Kogen does not teach the nipple adapter of Applicant's invention and in view of this fact the Examiner's argument can no longer support a rejection of claim 1 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

Applicant has cancelled claim 9 without prejudice, but has incorporated the limitations of claim 9 into claim 1 forming new claim 13. Consequently, Applicant is compelled to respond to this rejection. In claim 9 the Examiner states that Applicant's said means for affixing is identical to Kogen's element 30 of Figure 1. More specifically the Examiner states that the means for affixing comprises a pin 30 having a flat head 34 extending perpendicularly from the obverse side of the connector 30 and the cap 32 having a key-hole shaped slot 54 capable of receiving the pin head (54 of the cap receiving 46 in Fig. 1 notice how 46 fits into 54 with indentations on the top and bottom resembling a key-hole shape). Applicant respectfully disagrees.

Passageway 54 of Kogen is not, nor does it resemble in shape form or function the

keyhole shaped cavity taught by Applicant. The Examiner has attempted to equate the active press fit interface between Kogen's the flanged tubular member and the clutch member with Applicant's passive pin adapter interface with the key-hole cavity of the connector. They are not identical. Applicant discloses a passive cap cavity/adapter interface connection;

wherein the adapter is a pin with a head that may be received by the larger round opening of the key hole and the pin diameter being able to slip into the smaller elongated opening of the keyhole, locking the cap in place. (Page 19, lines 12-16)

Kogen teaches an active press-fit connection between the clutch member and the flanged tubular member having opposed linear slots 42 and annular recesses 44, 46 with chamfered ridges 48 that when press fit through passageway 54 locks the tubular member in place when the ridges expand upon reaching the rear surface of the flanged portion 50. The passageway 54 with indentations on the top and bottom in no way resembles a key-hole shaped opening as taught, disclosed and shown by Applicant's invention. Nor do the interfaces between the connector adapter and cap, and the flanged tubular member and clutch member function similarly. Applicant's action is a passive slipping of the pin head into the large round opening of the key-hole shaped opening and passing of the pin shaft into the smaller opening of the key-hole shaped opening thereby securing the cap in place. Kogen's invention uses an active interface wherein the flanges created by the linear slots are compressed by pressing the flanged tubular member into the passageway that snap into place when reaching the rear surface of the flanged portion to lock the protective insert in place. Therefore, Kogen does not claim, teach, disclose or discuss the pin and key-hole opening interface of Applicant's invention. Consequently, the Examiner argument can no longer support a rejection of claim 1 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

In item 9, the Examiner rejects claims 1, 3, 4 and 12 under 35 USC 102(b) as being anticipated by patent 216,954 issued to Heckmann. In regards to claim 1 the Examiner states that Heckmann teaches an earring comprising a shaft (b) mounted on a base (a) a connector (c) having a top surface (c') and a bottom surface (c''), a cavity (inside of c) with a means for engaging the shaft that fits flush against pierced ear on the bottom surface and an adapter projecting from the top surface of the connector on the obverse and a cap (f) having cavity (inside of f) to receive the adapter on one side and a decorative aspect of the earring on the obverse (f'). Applicant respectfully disagrees.

Applicant has amended claim 1 to include the limitations of claim 8 that more clearly defines the adapter as being a nipple. In addition the amendments more clearly define

the cap now comprising a flexible component capable of expanding to receive the nipple and retracting to grasp the nipple when the nipple and the cavity are pressed together.

The Heckmann patent cited by the Examiner does not claim, teach, disclose, show or discuss a nipple adapter on a connector that interfaces with a cavity of a cap. Nor does Heckmann claim, teach, disclose, show or discuss that the cap comprises a flexible component that expands to receive the nipple and retracting to grasp the nipple when the nipple and the cavity are pressed together. Consequently, the Examiner's argument can no longer support a rejection of claim 1 based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

The Examiner further rejects dependent claims 3 and 4 for the same reasons stated above for claim 1. Based on Applicant's arguments presented above the Examiner cannot support a rejection of these claims based 35 USC 102(b). In view of this, Applicant respectfully requests that the Examiner remove this rejection.

Claim 12 has been cancelled without prejudice consequently the Examiner's rejection is moot.

### B. Response to 35 U.S.C. §103 (a) Rejections

The Examiner has rejected claims 8 under 35 USC §103(a) as being unpatentable over Kogen in view of Float *et al.* US patent 5,893,278.

In regards to claim 8 the Examiner states that Kogen fails to teach a flexible component able to expand and retract to receive another component such as a connector. Float *et al.* teaches an assembly that has the ability to expand and retract around a stem of an earring. In view of Applicant's amendments to claim 1 and arguments demonstrating that Kogen does not teach Applicant's connector nipple adapter, the combination of the disclosure in Kogen with that of Float *et al.* also would not teach Applicant's connector nipple adapter. Consequently, all of Applicant's claim limitations are not taught by the combined references and the Examiner can no longer support a rejection of claims 8 based on 35 USC §103(a). Therefore, Applicant respectfully requests that the Examiner remove this rejection.

Claim 11 has been cancelled without prejudice consequently the Examiner's rejection is moot.

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Claims 1 and 10 have been amended identically to incorporate dependent claim 8 wherein the adapter is a nipple.

Applicant has cancelled claims 11 and 12 have been cancelled without prejudice to expedite allowance and added new claims 13-17. New claims 13 and 17 are identical to previous claims 1 and 10 incorporating dependent claim 9 wherein the adapter is a pin with a flat head. New claims 14-16 are identical to claims 2-4 but depend from new claim 13. Because claims 8 and 9 have been incorporated into independent claims 1,10, 13 and 17 they have been cancelled.

To the best of her knowledge Applicant believes that the amendments to the specification do not add new matter.

**CONCLUSION**

In view of the above arguments present Applicant has amended the claims and demonstrated that the invention as claimed satisfies the statutory requirements for patentability. Applicant's respectfully request that the Examiner issue an allowance of the claims.

Respectfully submitted,

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